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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,119	01/05/2004	Nizar Youssef Mehio	3117-101	1373

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EXAMINER

EDEL, JOHN B

ART UNIT	PAPER NUMBER
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1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/751,119

Applicant(s)

MEHIO, NIZAR YOUSSEF

Examiner

John B. Edel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24,25,27-40 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24,25,27-40 and 43-45 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Hereinafter, the format "26 [...]" is a double citation referring the reader to Applicants claim number (underlined) and prior art being cited (in brackets).

Claim Objections

In claim 28 "said burner" should read "a burner" because it is the first occurrence of "burner."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 40, and 43-45 rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 1,513,147 to Zahariadis ("Zahariadis"). Zahariadis teaches:

a base, dimensioned to contain a substantial amount of fluid, with a threaded upper end for receiving dry smoke 24 [figure 1]; and a stem (member 3 or members 3 and 6), having a threaded lower end configured to mate with said threaded upper end of said base, terminating in a selectively releasable peripheral down tube (element 16) dimensioned to substantially penetrate said base, said stem defining a dry smoke aperture oriented to conduct dry smoke into said base and a wet smoke aperture oriented to accept wet smoke from said base 24 [figure 1]

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a base (element 1) with a threaded connection for receiving dry smoke and dimensioned to contain a substantial amount of fluid
an intermediate tube (element 6) with a threaded connection;
a threaded plenum (element 18), releasably attached in gaseous communication with said intermediate tube, having a down tube for releasing dry smoke into said base; and
wet smoke conducting means (space inside element 18), disposed within said plenum and in gaseous communication with said base, for accepting and conducting wet smoke from said base 40 [figures 1 and 3]

said dry smoke means further comprises a separable down tube with a threaded connection adapted to releasably attach said separable down tube to said threaded plenum 43 [figure 1]
pressure stabilizing means¹ in gaseous communication with said base 44 [figure 1]
a cover means (element 9) adapted to house a substantial portion of the dry smoke conducting means 45 [figure 1]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

¹ All paths to the outside air could be classified as such a pressure stabilizing means.

Claims **25, 27-29, and 31-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Zahariadis as applied to claim 24 above, and further in view of the fact that it is notoriously well known that a male-female threading arrangement can be replaced with a female-male threading arrangement. It would be obvious to provide an internally threaded upper end of the base and a externally threaded lower end of the stem because reversing such threading is well known **25** [figure 1]. Zahariadis additionally teaches:

said stem comprises: an intermediate tube (element 3), having an upper end and a lower end, defining said dry smoke aperture; a plenum² (space encompassed by element 5 having both wet and dry smoke passage) further defining said dry smoke aperture and defining said wet smoke aperture, said plenum having an upper end adapted to removably fasten to said lower end of said intermediate tube; and wherein said down tube has an upper end adapted to removably fasten to said plenum **27** [figure 1]
an intermediate tube upper cap (element 8) in releasable attachment to both said intermediate tube and said burner **28** [figure 1]
an intermediate tube lower cap (element 5) in releasable attachment to both said intermediate tube and said plenum **29** [figure 1]
said intermediate tube is adapted to threadably fasten to said plenum and said plenum is adapted to threadably fasten with both said down tube and said base **31** [figure 1]
a burner adapted to removably fasten to said intermediate tube **32** [Figure 1]
said burner is adapted to threadably fasten to said intermediate tube **33** [figure 1].

Therefore, it would have been obvious to obtain the invention as specified in Claims **25, 27-29, and 31-33** based on the disclosure of Zahariadis.

² Plenum is interpreted broadly to include such meanings as 'a space filled with matter as opposed to a vacuum.'

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Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zahariadis as applied to claim 27 above, and further in view of the fact that it is notoriously well known to protect important parts of an apparatus with a cover or casing. It would be obvious to cover the intermediate tube of Zahariadis with a bag, casing, shielding, housing, or any number of other forms of protection which could be classified as a cover because doing so would protect the function of the device. Therefore, it would have been obvious based on Zahariadis to obtain the invention as specified in Claim 30.

Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganim in view of United States Patent No. 3,872,872 to Richard Kahler ("Kahler") and further in view of United States Patent No. 3,451,785 to R. G. Rohlfing et al. ("Rohlfing") as applied to claim 38 below.

Ganim discloses:

- A burner (P in figure 1),
- A threaded intermediate tube (F in figure 2) releaseably attached in gaseous communication with said burner (see attachment in figure 1),
- a threaded plenum (D in figure 2 and all the space within D), releasably attached in gaseous communication with said threaded intermediate tube (see attachment in figure 1),
 - defining a wet smoke aperture (B3 in figure 4 indicating the annular space through which the wet smoke would pass) for releasing wetted smoke to a user and
 - further having a down tube (H in figure 1) for releasing dry smoke; and
- a threaded base (see obvious to thread base above), releasably attached in gaseous communication with said plenum,
 - dimensioned to contain a substantial amount of fluid for receiving and wetting dry smoke (A in figure 1) 36.

Ganim does not disclose the burner being threaded. Kahler discloses screw threads as being a well known means of attachment. It would have been obvious to one having

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ordinary skill in the art to substitute the slip on fitting of Ganim with the screw on fitting of Kahler because such fittings are recognizes as equivalents (Ganim col.2 ln. 52-60).

Regarding Claim 37: Ganim discloses a down tube (H in figure 1) that is threaded and in gaseous communication with the plenum. The down tube is also releaseably attached to the plenum (threading at H1 in figure 2).

Pressure Relief valve: Ganim does not disclose a pressure release aperture obstructed by a pressure relief valve on hookah, or the threading of that pressure relief valve.

Rohlfing describes the use of pressure relief valves (col. 1 lines 30-37) to protect vessels from overpressure as "well known." Kahler describes screw threads as a well known means of connection (col. 4 lines 12-15) It would be obvious to provide a pressure relief valve obstructing a pressure release aperture on the stem of the hookah, at the plenum or in other appropriate locations and to use a threaded connection to connect that valve. The motivation for doing so is that a pressure relief valve would reduce the likelihood of an overpressure or underpressure of the vessel and that detachable components favor easy cleaning (Ganim Col. 2 lines 52-60). Rohlfing is analogous art to Ganim because it is pertinent to the problem of unsatisfactory pressure within the hookah.

Regarding Claim 38: Claims 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ganim and Kahler as applied to claim 37 above, and further in view of Rohlfing. For the reasons stated above in the section entitled "Pressure Release Valve" it would have been obvious to a person having ordinary skill in the art to include a pressure release aperture obstructed by pressure release valve as described in

Rohlfing in the plenum of the hookah set out in Ganim and Kahler to obtain the invention as specified in claim 38.

Claims 34, 35, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zahariadis as applied to claim 24 above, and further in view of Ganim and Kahler. Rohlfing and Kahler disclose what Zahariadis fails to disclose expressly, namely that pressure relief valves are used for protecting vessels and that screw threads are a common means of connection. Rohlfing is analogous art to Zahariadis because it is pertinent to the problem of unsatisfactory pressure within the hookah. Kahler and Zahariadis are analogous because Kahler relates to a problem posed by Zahariadis, namely what are acceptable means of attachment. It would be obvious to use a screw attachment to attach a pressure relief valve to the stem/plenum because screw attachments are well known means of attachment and pressure relief valves protect vessels. Therefore, it would have been obvious to combine Rohlfing and Kahler with Zahariadis to obtain the invention as specified in Claims 34, 35, and 39.

Response to Arguments

Applicant's arguments filed January 5, 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the stem) are not recited in the rejected claim(s) 36-38. Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims 36-38 Applicant argues there is no motivation to combine the references. Applicant failed to dispute that a threaded fitting and the slip on fitting are substitutes. It is within the skill of a person having ordinary skill in the art of making water pipes to make substitutions which are recognized in the art. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Applicant's arguments relating to the remaining claims are moot based on the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Edel whose telephone number is (571) 272-4804. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBE


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